

REMARKS

Claims 38-42 and 44-54 are pending in the application. Claims 39-41, 44, 45, 53 and 54 have been allowed. Claims 38, 42, 46-50 and 51-52 have been subjected to a restriction requirement. In view of the remarks that follow, Applicants respectfully request that the Examiner withdraw the restriction requirement and allow all of the pending claims to issue.

In the Office Action a restriction requirement was imposed as to amended claims 38, 42, and 46-50, and newly submitted claims 51-52, which are collectively drawn to products containing polymer surfaces. Citing MPEP § 821.03 and 37 C.F.R. § 1.142(b), the Examiner found these claims to be directed to an invention that is independent of or distinct from the invention originally claimed because these claims are directed to a carbon-containing polymer surface, while the original claims were believed to be directed to a carbon-containing inorganic surface. Applicants respectfully traverse.

According to MPEP § 803, two criteria must be met for a restriction requirement to be proper. First, the inventions must be independent or distinct as claimed. Second, a serious burden must be imposed on the Examiner if the restriction is not required. As stated in MPEP § 803, “if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Applicants respectfully submit that the present restriction requirement meets neither criterion.

In the Office Action the Examiner asserts that the amended and newly submitted claims are directed to an invention that is independent or distinct from the invention originally claimed because, “These claims are directed to a carbon-containing polymer surface while the original claims are directed to a carbon-containing inorganic surface.” Applicants respectfully point out that MPEP 821.03 applies to claims added by amendment following action by the examiner, to an invention *other than* previously claimed. However, the original claims did in fact include

claims directed to carbon-containing polymer surfaces. For example, original claims 42 and 43 read as follows:

42. A carbon-containing substrate comprising:
 - (a) a carbon-containing substrate surface;
 - (b) one or more molecular spacer chains covalently bound to the surface, the one or more spacer chains having a length of at least 2.5 nm; and
 - (c) one or more biomolecules covalently bound to the one or more molecular spacer chains.
43. The substrate of claim 42, wherein the substrate surface comprises a *polymeric surface*.

In Applicants' response filed on January 11, 2006, claim 43 was cancelled and claim 38 was amended to include the limitation of claim 43 that the carbon-containing surface is a polymer surface. Because the amendment of claim 38 incorporated a limitation that was already present in the original claims, namely claims to carbon-containing surfaces that comprise polymeric surfaces, Applicants respectfully argue that the present restriction requirement is improper, since claims to polymeric surfaces were previously claimed. Applicants therefore respectfully request that the Examiner withdraw the present restriction requirement.

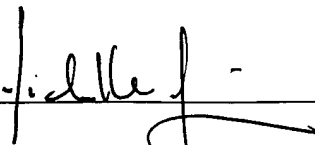
Applicants further submit that the present restriction requirement is improper because withdrawal will not result in the serious burden required under MPEP § 803. Where the inventions have the same classification and the same field of search and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among inventions. (MPEP § 808.02) In the Restriction Requirement mailed on August 4, 2005, the Examiner acknowledged that the claims directed to carbon-containing polymer surfaces (such as originally filed claim 43) and claims directed to other types of carbon-containing surfaces (such as originally filed claims 39 and 40) have a common classification, namely class 435, subclass 402, drawn to biomolecule bound substrates.

In addition, because the Examiner has *already* conducted a search of the prior art relevant to claims directed to both carbon-containing polymer surfaces *and* other types of carbon-containing surfaces, it would be unreasonable to suggest that the continued examination of both types of claims would now require a separate search. Applicants point out that the first Office Action issued by the Examiner, mailed October 11, 2005, rejected claims 42 and 43 (i.e., claims directed to carbon-containing polymer surfaces) under 35 U.S.C. § 103, citing prior art references that disclosed carbon-containing polymer surfaces. For example, the Examiner cited the Noetzel patent (U.S. Patent No. 4,568,706) as teaching a biomolecular carrier comprising a *polymeric substrate* and a spacer. Thus, it is clear that substantial prosecution on the merits, including a search and examination of the relevant polymer surface art, has already occurred with respect to claims directed to carbon-containing polymeric surfaces.

For the reasons discussed above, Applicants respectfully submit that the continued examination of the restricted claims would not impose a serious additional burden on the Examiner. For this additional reason, Applicants respectfully request that the restriction requirement be withdrawn. Applicants further respectfully submit that all of the claims pending in the application are now in condition for allowance. Consequently, Applicants respectfully request that Examiner allow the application to issue. The Examiner is invited to contact the undersigned by telephone if it is thought that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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Date September 1, 2006

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